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10/031,218	05/07/2002	Marcus Filshie	02597	2627

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EXAMINER

EREZO, DARWIN P

ART UNIT	PAPER NUMBER
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3773

NOTIFICATION DATE	DELIVERY MODE
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01/31/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/031,218	Applicant(s) FILSHIE ET AL.	
	Examiner Darwin P. Erez	Art Unit 3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-12, 14-17, 26, 27, 31, 32 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-12, 14-17, 26, 27, 31, 32 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action is in response to the applicant's communication filed on 11/17/10.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 14 and 15 recite: "A surgical clip...including a tubular storage member" which implies that the clip includes/comprises the tubular storage. However, the following limitation "the surgical clip is constructed and arranged for passage through the tubular member" contradicts the previous statement. The latter limitation implies that the tubular member is a separate structure from the clip, and that the clip passes through the tubular member". It is unclear how the clip (which includes the tubular storage member) can pass through the tubular storage member, which would make it appear that the clip passes through itself. Since the limitations are conflicting, the claims are rendered vague and indefinite.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 2, 4-9, 11, 12, 16, 17, 26, 27, 31, 32 and 34 are rejected under 35

U.S.C. 102(b) as being anticipated by US 2,568,511 to Ogden.

Ogden discloses a clip capable for use during surgery, as shown in the illustrated figure 4 below, the clip comprising:

an elongate upper jaw 15 having a proximal end and a distal end, and an elongate lower jaw 10 having one and other ends;

a hinge member 16 that supports at a base thereof the one end of the elongated lower jaw;

said elongated lower jaw including an elongated substantially straight piece 10 extending from said base, and at the other end thereof a reversed segment 20 contiguous with said elongated substantially straight piece and forming a latch for engagement with the upper jaw;

said reversed segment being substantially shorter in length than the length of said elongated substantially straight piece;

said hinge member including a hinge pin 17 disposed over the back of the hinge member and spaced from and over the one end of the elongated lower jaw;

said elongated upper jaw including, at the proximal end thereof, a first straight section supported for pivoting at the hinge pin (see figure below), and an arcuate shaped section contiguously adjoining the straight section and extending distally thereof and away from the hinge pin (see figure below);

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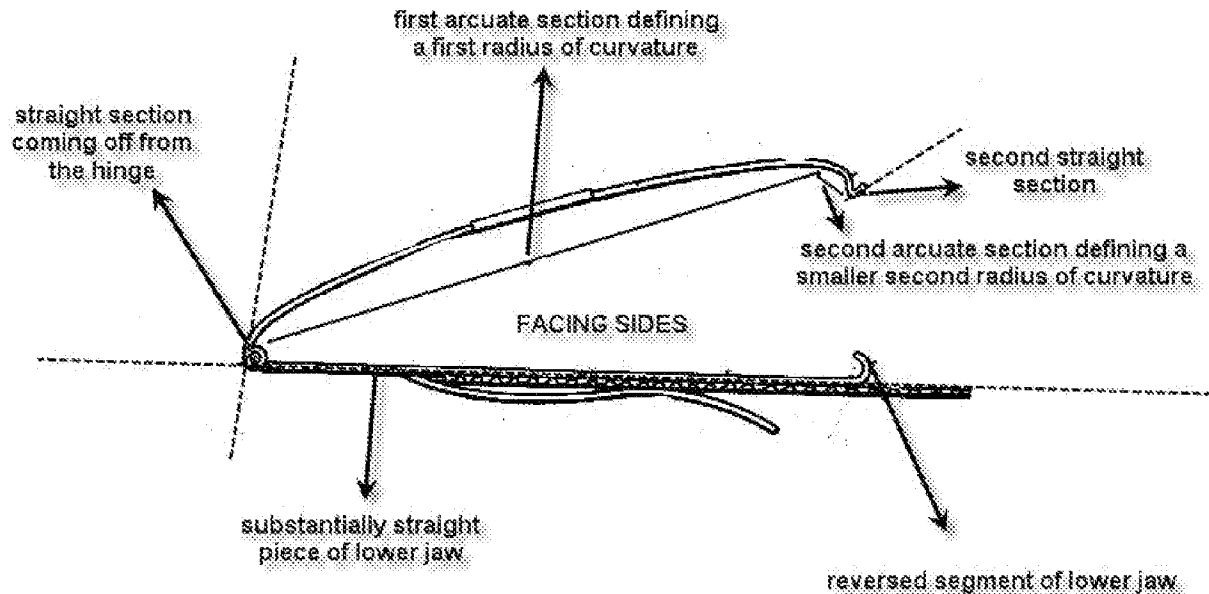
said arcuate shaped section including a first arcuate shaped portion contiguous with said straight section and a second arcuate shaped portion contiguous with said first arcuate shaped portion disposed at an opposite end of said first arcuate shaped portion to said straight section (see figure below);

said elongated upper and lower jaws having respective facing surfaces (see figure below);

said first arcuate shaped portion having a first radius of curvature in its facing surface that is greater than a radius of curvature of said second arcuate shaped portion which has a second radius of curvature in its facing surface (see figure below);

wherein the first and second arcuate shaped portions are both defined in the facing surface of the upper jaw (see figure below);

wherein the first radius of curvature and the second radius of curvature are both defined by respective centers of curvature below the upper jaw (see figure below).



Ogden also discloses:

a second straight section (distal generally straight section having a free end) adjacent to said second arcuate shaped portion at the opposite end of said second arcuate shaped portion to the hinge pin, said second straight section, when in the closed position of the clip, interlocking under the latch of the lower jaw (see figure above);

wherein said first arcuate shaped portion has the same width therealong and as measured in the direction of the first radius of curvature (see Fig. 1);

wherein said second arcuate shaped portion has the same width therealong and as measured in the direction of the second radius of curvature (see Fig. 1);

wherein, when the upper jaw is distorted it fits within the latch because an initial closure pressure is imposed on the straight section and thus the initial pressure fails to distort the arcuate shaped section until the free end has been depressed toward the lower jaw (Fig. 3);

wherein the total length of the first and second arcuate shaped portions is greater than the length of the straight section (see figure above);

wherein the length of the first arcuate shaped portion is greater than the length of the second arcuate shaped portion;

wherein there is an absence of any straight portion or arcuate portion between said first and second arcuate shaped portions (see figure above);

wherein the first arcuate shaped portion is contiguous with the second arcuate shaped portion forming a complex contiguous curved shape (see figure above);

wherein said second arcuate shaped portion has an arcuate surface on both an outer contact surface thereof and an inner surface thereof (see figure above);

wherein the straight section has the same width therealong and is substantially flat on both outer and inner surface.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ogden.

Ogden discloses all the limitations of the claim except for the ratio between the first radius of curvature to the second radius of curvature. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to arrive at the recited ratio since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ogden in view of US 1,830,039 to Rosicky.

Ogden discloses all the limitations of the claim except for the jaws being provided with a silicone rubber lining. However, Rosicky discloses that it is well known in the art to provide cravat/necktie holders with a rubber lining (line 64). Therefore, it would have been obvious to one of ordinary skill in the art to provide a rubber lining to the holder of Ogden as it would provide more traction to the holder. It would also be obvious to use silicone rubber since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter

of obvious design choice. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).
Silicone rubber is a well known material.

Response to Arguments

10. Applicant's arguments with respect to claims 2-12, 14-17, 26, 27,31,32 and 34 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darwin P. Erez who's telephone number is (571)272-4695. The examiner can normally be reached on M-F (8:00-4:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Darwin P. Erez/
Primary Examiner, Art Unit 3773